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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/985,952	11/06/2001	Richard J. Wise	053837-5001	4205

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EXAMINER

RODRIGUEZ, JOSEPH C

ART UNIT	PAPER NUMBER
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3653

DATE MAILED: 06/19/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/985,952

Applicant(s)

WISE, RICHARD J.

Examiner

Joseph C Rodriguez

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-57 is/are pending in the application.
- 4a) Of the above claim(s) 9-57 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-8 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 06 November 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 5.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

**DETAILED ACTION**

***Election/Restrictions***

Applicant's election of group I (claims 1-8) in Paper No. 7 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

Claims 9-57 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected species, there being no allowable generic or linking claim.

***Drawings***

The drawings are objected to as failing to comply with 37 CFR 1.84(g) as the drawings (Fig. 1, 3a, 3b, 4 and 7) do not satisfy the margin requirements. This deficiency may negatively impact their reproduction.

The drawings are objected to as failing to comply with 37 CFR 1.84(l) as the character of the lines (Fig. 1, reference characters) are of insufficient quality to differentiate adjacent elements, to facilitate reproduction and/or to ascertain what applicant is describing in the specification.

The drawings are also objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the motor of claims 1 and 5 must be shown or the feature canceled from the claims. No new matter should be entered.

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A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim 1, 6 and 8 are rejected under 35 U.S.C. 102(b) as being anticipated by DE 311 387 ("DE '387").

Regarding claims 1 and 8, DE '387 teaches an apparatus (Fig. 1, 2) comprising a first conveyor (a) with paddles (d), a second conveyor (f), a motor (inherent), an enclosure (Fig. 2, surrounding d), and a magnetic assembly (near b).

Regarding claim 6, this feature is present according to the International Search Report.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 3-5 are rejected under 35 U.S.C. 103(a) as being unpatentable over DE '387 in view of legal precedent.

DE '387 as set forth above teaches all that is claimed except for expressly teaching an adjustable support, a different magnetic field strength, and speed ratio. These features, however, are well-known in view of legal precedent. For instance, the court has held that adjustability is not a patentable advance. See MPEP 2144.04 IV (D). Further, the court has held that the mere optimization or selection of ranges, such as a field strength or ratio, is non-obvious. See MPEP 2144.05. Here, the magnetic field strength and speed ratio are common parameters that one with skill in the art would know to adjust dependent on the desired separation parameters. Therefore, it would have been obvious at the time the invention was made to a person having ordinary skill in the art to modify the invention of DE '387 as in view of legal precedent.

Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over DE '387 in view of Soley (US '489).

DE '387 as set forth above teaches all that is claimed except for expressly teaching removably mounting the magnetic separation assembly. Soley, however, teaches this feature by teaching that a variety of magnet types can be used in an assembly, thus implicitly teaching that the magnets can be interchanged via removable mounting (Fig. 1; col. 5, ln. 22-35). Moreover, this feature allows the apparatus to be adapted to meet more specific separation requirements (Id.). Therefore, it would have been obvious at the time the invention was made to a person having ordinary skill in the

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art to modify the invention of DE '387 as taught above to broaden the applications of the apparatus.

Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over DE '387 in view of what is well known in the art.

DE '387 as set forth above teaches all that is claimed except for expressly teaching the use of magnetic sections of differing compositions. This feature, however, is well-known in the magnet separating arts and Examiner takes Official Notice of such. The mere use of magnets with different compositions cannot be regarded as novel when it is well known to use magnets of different compositions depending on the material to be separated. Therefore, it would have been obvious at the time the invention was made to a person having ordinary skill in the art to modify the invention of DE '387 as taught above.

### ***Conclusion***

Any references not explicitly discussed above but made of record are considered relevant to the prosecution of the instant application.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joseph C Rodriguez whose telephone number is **703-308-8342**. The examiner can normally be reached on M-F during normal business hours (9 am – 6 pm, EST).

The examiner's **Personal fax number** is **703-706-3678**.

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The **Official** fax phone number for the organization where this application or proceeding is assigned is **703-306-4195**.

The **UnOfficial** fax phone number for the organization where this application or proceeding is assigned is **703-306-2571 or 703-308-6552**.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the **Receptionist** whose telephone number is **703-308-1113**.

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June 13, 2003

  
DONALD T. WALSH  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 3600